

**REMARKS**

Applicant respectfully requests reconsideration and allowance of claims 1-14, 31, 32, and 34 that are pending in the above-identified patent application. Applicant has amended claim 1 to clarify claim language. No new matter has been added by the claim amendments. In view of the following discussion, Applicant submits that all pending claims are in condition for allowance.

At page 2 of the Office Action, the Examiner noted that a complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action. Applicant has canceled claims 15-30, 33, and 35 in accordance with MPEP §821.01.

At page 3 of the Office Action, the Examiner rejected claims 1-14, 32, and 34 under 35 U.S.C. § 103(a) as being unpatentable over Casper et al. (U.S. Pat. No. 6,644,309) (“Casper”) in view of Hochrainer et al. (U.S. Pub. No. 2003/0070679) (“Hochrainer”). Applicant respectfully traverses the Examiner’s rejection.

As an initial matter, Hochrainer is 35 U.S.C. §102(e) prior art and must be removed as a reference pursuant to 35 U.S.C. § 103(c). Applicant submits that Hochrainer and the instant application were both assigned (or subject to an employment agreement to assign) to the same entity, Boehringer Ingelheim, at the time the instant application was filed. As such, Applicant submits that Hochrainer et al. must be removed as a reference on procedural grounds, i.e., pursuant to 35 U.S.C. § 103(c). In view of the above, Applicant submits that claims 1-14, 32, and 34 are patentable. Nevertheless, below Applicant makes additional statements on the merits.

Amended independent claim 1 recites, “...a container cartridge having a non-pressurized cylinder, at rest, containing a single-dose of the drug, a piston in the cylinder, and an outlet end opposite the inlet end having a dispensing facility and means for feeding the drug thereto; an elastic element for the storage of a predetermined quantity of energy; a mobile element to which the predetermined quantity of energy can be fed and which is coupled to the piston such that the energy can move the piston and expose the single-dose of the drug to a predetermined increase in pressure within the cylinder...”

The Examiner alleges that Casper discloses an elastic element and a mobile element. Applicant respectfully disagrees with the Examiner. As recited in claim 1, the elastic element stores a predetermined quantity of energy, and the release of the elastic element releases energy, which moves the piston *within the chamber of the cartridge* to produce a pressure change to release the medicament. In Casper, the coil spring 34, which the Examiner alleges is the elastic element, does not store a predetermined quantity of

energy, which is later released to move the piston and produce a pressure change in the chamber. Indeed, the coil spring 34 of Casper is compressed when a user drives and locks into place a plunger and stopper assembly 22. This process creates pressure in the pressure chamber 92 between the stopper 28 and the inlet valve 56 (not in the cartridge 72). The user opens a valve 56 to release the pressure in the pressure chamber 92 into the inlet opening 68, which ruptures the burstable membranes 86 of the cartridge 72 to deliver the drug. As such, Casper does not have an elastic element for the storage of a predetermined quantity of energy which moves a piston in a chamber containing the drug as claimed. Hochrainer does not cure this deficiency.

Casper does not disclose a “mobile element” as recited in claim 1 of the present invention. As claimed, the predetermined energy is fed into the mobile element which is coupled to the piston such that the mobile element moves the piston (within the chamber of the cartridge) and exposes the drug to an increase in pressure in the cylinder. In Casper, the piston 30, which the Examiner alleges is the mobile element, does not receive the quantity of energy stored in the pressure chamber 92; rather, such energy is released through a valve 56 to the cartridge 72. As such, Casper lacks the mobile element recited in claim 1 of the present invention. Hochrainer does not cure this deficiency.

Applicant submits that the combined teachings of the cited art fail to disclose all of the features of the invention as claimed in independent claim 1, or dependent claims 2-14, 31, 32, and 34 of the instant application. Accordingly, Applicant respectfully requests that the Examiner’s § 103(a) rejection be withdrawn.

In view of the foregoing, Applicant submits that the instant claims are in condition for allowance. Early and favorable action is earnestly solicited. In the event there are any fees due and owing in connection with this matter, please charge same to our Deposit Account No. 11-0223.

Dated: November 6, 2007

Respectfully submitted,

By s/Matthew B. Dernier/  
Matthew B. Dernier  
Registration No.: 40,989  
KAPLAN GILMAN GIBSON & DERNIER LLP  
900 Route 9 North, Suite 104  
Woodbridge, New Jersey 07095  
(732) 634-7634  
Attorneys for Applicant